The Legal Standard

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

35 U.S.C. § 103(a) Rejections

Claims 1-35 were rejected under 35 U.S.C. § 103(a) as obvious over Lipkin (US 5,592,377) in view of So (US 4,990,848) and Atkins (US 5,644,727) and Batson (US 5,844,327) and Official Notice. These rejections are respectfully traversed.

The Action alleges that the pending application and the parent application 09/037,559 have similar claims. The 35 U.S.C. § 103(a) rejections substantially follow those previously presented in parent application. Likewise, Applicants' response is similar to the previously submitted (in the parent application) rebuttal. Applicants' remarks in the parent application are also incorporated herein by reference. Applicants' response in the parent application resulted in allowance thereof. Hence, allowance of all of Applicants' claims is respectfully requested.

Claim 1

The Lipkin reference does not teach or suggest numerous recited features and relationships. In Lipkin system a person seeking to cash a check provides their name through a telephone handset and a teller or operator may look up a picture corresponding to the name that is given by the customer and compare the person at the customer station to the picture. Nothing in Lipkin discloses a processor, in operative connection with an imaging device, that is operative responsive to image input signals to resolve a first identity data as recited in claim 1. Likewise nothing in Lipkin discloses a processor, in operative connection with an audio input device, that is operative responsive to audio input signals from the voice of a user to resolve second identity data. Indeed nothing in Lipkin discloses or suggests resolving anything about the person's identity based on voice signals.

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Nothing in Lipkin discloses or suggests comparing identity data resolved from image data and from voice data for a level of correlation. Nothing in Lipkin discloses or suggests that the operation of a transaction function device is enabled when a level of correlation between the first and second identity data is reached.

Lipkin is a manual system where an operator looks up information corresponding to one name given by a customer, and may make a determination as to whether a picture associated with that name is a picture of the person at the customer station. Lipkin does not teach or suggest a "processor" that is in operative connection with an imaging device, an audio input device, a data store, and a transaction function device.

The teachings of So, Atkins, Batson, and the Official Notice do not teach or suggest the elements recited in Applicants' claim which are not disclosed in Lipkin. For example, where does either of these references disclose or suggest a data store including stored user data corresponding to a plurality of users? In addition, there is no teaching, suggestion or motivation in the secondary references to combine their teachings either together or with the teachings of Lipkin.

So teaches a DTMF receiver which executes an algorithm which distinguishes DTMF signals from other noise on a transmission line. Nothing in So discloses or suggests identifying a person's identity in response to voice signals. So is non analogous art.

The Action further does not contain any citation to any teaching, suggestion or motivation for one having skill in the art to combine the teachings in So with the teachings of Lipkin. Lipkin does not disclose or involve the use of DTMF signals. There is no use for any DTMF signals in the operation of the system as described in Lipkin. For these reasons there is no

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teaching, suggestion or motivation for anyone to combine the teachings of So with the teachings of Lipkin.

For these reasons So adds nothing to the teachings of Lipkin and clearly does not provide any teaching or suggestion of the features and relationships recited in claim 1 which are lacking in the Lipkin reference. Furthermore, there is no teaching, suggestion or motivation to combine any features of So with the teachings of Lipkin, as to do so would provide no useful purpose.

Atkins also does not provide any teaching or suggestion of the features that are specifically recited in claim 1 and which are absent in the Lipkin reference.

Atkins recites a terminal which includes an authorization procedure to be sure that the owner of the terminal is operating it. The procedure described in Atkins is to use a three part verification test by a user to check against corresponding data for the owner of that terminal. If all three tests are satisfied then the terminal is enabled to execute a transaction.

It is respectfully submitted that the teachings of Atkins are substantially the same as those of Lipkin. Atkins tests to see if input data from a user corresponds to data for the single authorized user stored in the terminal. This is similar to the situation in Lipkin where the teller may look up a picture which corresponds to a name given by a person seeking to cash a check. If this input data corresponds to the one user against whose data a test is made, the transaction proceeds. If the input data does not correspond to this one user the transaction does not proceed.

The Atkins device does not resolve first identity data or second identity data from a data store which includes data related to a plurality of users. Likewise Atkins does not disclose or suggest to compare first identity data (based on a user's image) and second user identity data (based on a user's voice) for a level of correlation. Atkins checks each input against its stored

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data to make a "go/no go" determination. Nothing in Atkins discloses or suggests comparing two items of information resolved responsive to two separate customer inputs for a level of correlation.

Batson also does not provide any teaching or suggestion of the features that are specifically recited in claim 1 and which are absent in the Lipkin reference.

The Action's cited portion of Batson (Column 11, lines 45-49) has to do with a battery charger profile management routine which operates to modify a battery charging rate with temperature. However, nothing in Batson's power supply system is applicable to, usable in, or even pertains to the same field of technology. It follows that Batson is non analogous art.

For these reasons neither Lipkin, So, Atkins, Batson, nor the Official Notice disclose or suggest the features and relationships specifically recited in claim 1. Nor is there any teaching, suggestion or motivation to combine features of these references so as to produce the recited invention. Applicants respectfully submit that neither Lipkin, So, Atkins, Batson, nor the Official Notice, taken alone or in combination, teach or suggest the recited features and relationships. Thus, the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claims 14, 18, 25-32

Applicants' remarks in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein. As previously discussed, nothing in the cited art discloses or suggests the recited features and relationships. Applicants respectfully submit that neither Lipkin, So, Atkins, Batson, nor the Official Notice, taken alone or in combination, teach or suggest the recited features and relationships. It follows that the 35 U.S.C. § 103(a) rejections should be withdrawn.

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The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. The independent claims have been previously shown to be allowable. Thus, it is asserted that the dependent claims are allowable on the same basis.

Furthermore, each of the dependent claims additionally recites specific features and relationships that patentably distinguish the claimed invention over the applied art. None of the references, taken alone or in combination, teach or suggest the features and relationships that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features and relationships.
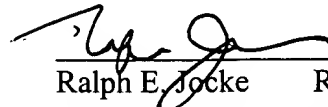
Additional Comments

The Action (paragraph number 11) refers to the prior art cited in the parent application (US 6,023,688). Applicants respectfully request that this referenced prior art and the applied references of Lipkin, So, Atkins, Batson, and US 6,023,688 be included on form PTO-892 in accordance with MPEP § 707.05(a) and 707.05(c).

Conclusion

Each of Applicants' pending claims specifically recite features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any such teaching, suggestion or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,

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